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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/668,005	09/21/2000	Tomotoshi Sato	49986-0500	8312
29989	7590	10/25/2005		EXAMINER
				HUTTON JR, WILLIAM D
			ART UNIT	PAPER NUMBER
			2176	

DATE MAILED: 10/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.



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Technology Center 2100

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/668,005
Filing Date: September 21, 2000
Appellant(s): SATO, TOMOTOSHI

Edward A. Becker, Reg. No. 37,777

For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 11 August 2005 appealing from the Office Action mailed 11 February 2005.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) *Grounds of Rejection to be Reviewed on Appeal*

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) *Claims Appendix*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) *Evidence Relied Upon*

No evidence is relied upon by the examiner in the rejection of the claims under appeal.

(9) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-12, 14-39, 41-56 and 58-76 remain rejected under 35 U.S.C. 102(e) as being anticipated by Blumberg et al., U.S. Patent Application Publication US 2003/0140315 A1.

Claim 1:

Blumberg discloses a *method for previewing an electronic document* (see Page 1, Paragraph 0009 – Blumberg discloses this limitation in that the cited paragraph states, “A user using the present invention can see on his video monitor how a document will look as a finished document” (emphasis added).), *the method comprising:*

- *generating the electronic document at a client* (see Page 1, Paragraph 0011; see Page 7, Paragraph 0143 – Blumberg discloses this limitation in that the computerized printing system comprises: 1) content-level proofing, typically accomplished with a viewer such as Microsoft Word; and 2) a document authoring tool with a web interface, wherein said document authoring tool produces documents. Thus, at a minimum, Blumberg impliedly discloses “*generating [an] electronic document at a client.*”);
- *transmitting document information associated with the electronic document from the client to a printing device having a print process for generating hard-copy printouts of electronic documents at the printing device* (**EXAMINER'S INTERPRETATION OF “PRINTING DEVICE”** – In the Drawings and Specification of the present invention, the “*printing device*” is illustrated in Figure 1A (element 102), Figure 1B (see element 102) and described in the text from

Page 8, Line 3 to Page 11, Line 21. As illustrated in Figure 1A, the “*printing device*” comprises a “server process” (element 114) that receives print preview requests from a client (see Specification – Page 10, Lines 7-10). As illustrated in Figure 1B, the “*printing device*” comprises a “web server” (element 114) and a “system bus” (element 130) that allows a client to communicate with the printing device (see Specification – Page 11, Lines 10-21). In **Blumberg** – see Figures 2 and 3; see Page 3, Paragraph 0058 through Page 4, Paragraph 0074; see Page 7, Paragraph 0141 through Page 8, Paragraph 0154 – Blumberg discloses this limitation in that the computerized printing system comprises: 1) a computer network, comprising the components and connections of the system; 2) Virtual Builder, residing on servers and allowing a client user to select and view finishing options for a document via the client/server system; and 3) print servers connected to printers, for printing the document. Virtual Builder may reside only on server computers (see Page 3, Paragraph 0060, first sentence). Virtual Builder is implemented by software that interacts with web browser software on a client computer (see Page 3, Paragraph 0061, first sentence). The servers present a client user with an interface that enables him to select various finishing options (see Page 4, Paragraph 0065, first sentence). The client user can import a document into Virtual Builder (see Page 4, Paragraph 0066) and select various finishing options for the document (see Page 4, Paragraphs 0067-0073). Virtual Builder then displays the finished document (see Page 4, Paragraphs 0075-0076). Subsequently, the client user may submit the document to print

servers in order to print the document (see Page 7, Paragraph 0142).

Accordingly, Blumberg discloses "*transmitting document information associated with the electronic document from the client to a printing device having a print process for generating hard-copy printouts of electronic documents at the printing device.*");

- *the printing device generating preview document data based on the document information and a set of one or more specific characteristics associated with the printing device, wherein the set of one or more specific characteristics are unavailable at the client* (see Page 2, Paragraphs 0011-0012; see Page 4, Paragraphs 0064-0083 – Blumberg discloses this limitation in that the computerized printing system distinguishes "content-level" proofing and "document-level" proofing (see Page 2, Paragraphs 0011-0012). "Content-level" proofing is performed at the client using only wordprocessing software like Microsoft Word. "Document-level" proofing is also performed at the client; however, this type of proofing uses the Virtual Builder software, which is not available at the client until it is accessed from the server through the computer network. Thus, the finishing options, available through use of Virtual Builder, comprise "*specific characteristics [that] are unavailable at the client.*" Using the finishing options selected by the client user, Virtual Builder generates and displays the finished document (see Page 4, Paragraphs 0064-0083). Accordingly, Blumberg discloses "*the printing device generating preview document data based on the document information and a set of one or more*

specific characteristics associated with the printing device, wherein the set of one or more specific characteristics are unavailable at the client.");

- *the printing device transmitting the preview document data to the client* (see Page 4, Paragraphs 0064-0083 – Blumberg discloses this limitation in that the computerized printing system comprises Virtual Builder. As indicated in the above discussion, Virtual Builder generates and displays the finished document (see Page 4, Paragraphs 0064-0083). Accordingly, Blumberg discloses "*the printing device transmitting the preview document data to the client.*"); and
- *previewing the electronic document at the client based on the preview document data received from the printing device* (see Page 4, Paragraph 0075 through Page 5, Paragraph 0090 – Blumberg discloses this limitation in that the computerized printing system comprises Virtual Builder, which allows the user to preview and interact with the finished document at the client computer (see Page 4, Paragraph 0075 through Page 5, Paragraph 0090). Accordingly, Blumberg discloses "*previewing the electronic document at the client based on the preview document data received from the printing device.*").

Claim 2:

Blumberg discloses *the method of Claim 1, wherein:*

- *the printing device is a multi-functional printer (MFP)* (The servers on which Virtual Builder resides are "*multi-functional printer(s)*" in that the servers and Virtual Builder comprise an online "printer" that will print the submitted document

as it would appear in its “finished” state. That is, the “finished” document that is printed will have the “look and feel” of an “actual” document.); **and**

- *the step of transmitting the document information includes transmitting document information to the MFP* (As explained in the above rejection for Claim 1, the “document information” is transmitted to the servers and Virtual Builder.).

Claim 3:

Blumberg discloses *the method of Claim 1, wherein:*

- *the document information is Page Description Language (PDL) data* (The “document information” is PDL data in that the document is created using a typical word processor.); **and**
- *the step of transmitting document information includes transmitting PDL data from the client to the printing device* (As explained in the above rejection for Claim 1, the “document information” is transmitted to the servers and Virtual Builder.).

Claim 4:

Blumberg discloses *the method of Claim 1, wherein the step of generating preview document data at the printing device includes generating raster image data at the printing device based upon the document information and the set of one or more specific characteristics associated with the printing device* (Page 6, Paragraphs 0107-0110).

Claim 5:

Blumberg discloses *the method of Claim 1, wherein the step of generating preview document data at the printing device includes generating a bitmap image at the printing device based upon the document information and the set of one or more specific characteristics associated with the printing device* (Page 9, Paragraphs 0184 and 0188).

Claim 6:

Blumberg discloses *the method of Claim 1, wherein:*

- *the printing device is associated with one or more different paper characteristics that are available for printing electronic documents* (Page 4, Paragraph 0068);
and
- *the set of one or more specific characteristics associated with the printing device includes one or more of the one or more different paper characteristics that are available for printing electronic documents* (Page 4, Paragraph 0068).

Claim 7:

Blumberg discloses *the method of Claim 6, wherein the one or more different paper characteristics includes one or more paper type characteristics, wherein the one or more paper type characteristics indicate a specific type of paper that has been for printing the electronic document* (Page 4, Paragraph 0068).

Claim 8:

Blumberg discloses *the method of Claim 6, wherein the one or more different paper characteristics includes one or more paper color characteristics, wherein the one or more paper color characteristics indicate a specific color of paper that has been for printing the electronic document* (Page 4, Paragraph 0068).

Claim 9:

Blumberg discloses *the method of Claim 1, wherein:*

- *the printing device supports one or more different fonts that are available for printing electronic documents* (Page 4, Paragraph 0174); and
- *the set of one or more specific characteristics associated with the printing device includes one more of the one or more different fonts that are available for printing electronic documents* (Page 4, Paragraph 0174).

Claim 10:

Blumberg discloses *the method of Claim 1, wherein:*

- *the printing device is associated with one or more different stapling characteristics that are available for selection* (Page 4, Paragraph 0071 and Page 10, Paragraph 0193); and
- *the set of one or more specific characteristics associated with the printing device includes one or more of the one or more different stapling characteristics that are available for selection* (Page 4, Paragraph 0071 and Page 10, Paragraph 0193).

Claim 11:

Blumberg discloses *the method of Claim 1, wherein:*

- *the printing device is associated with one or more different finishing characteristics that are available for selection* (Page 4, Paragraphs 0064-0074);
and
- *the set of one or more specific characteristics associated with the printing device includes one or more of the one or more different finishing characteristics that are available for selection* (Page 4, Paragraphs 0064-0074).

Claim 12:

Blumberg discloses *the method of Claim 1, wherein:*

- *the client includes a print driver that is associated with the printing device* (the document is created using a word processor; all computers with word processors *inherently* have a print driver); *and*
- *the set of one or more specific characteristics that are unavailable at the client includes one or more characteristics that are unknown to the print driver* (Page 4, Paragraphs 0064-0074 – the “specific characteristics” unknown to the print driver include covers, paper types and bindings).

Claim 14:

Blumberg discloses *the method of Claim 1, wherein:*

- *the step of generating preview document data at the printing device further includes the steps of determining the resolution of a display device that is associated with the client (Page 7, Paragraph 0138 and Page 9, Paragraph 0174); and*
- *generating the preview document data based on the resolution of the display device (Page 7, Paragraph 0138 and Page 9, Paragraph 0174).*

Claim 15:

Blumberg discloses *the method of Claim 1, wherein:*

- *the step of generating preview document data at the printing device includes the steps of generating two-dimensional (2-D) preview document data (see Figure 1); and*
- *the step of displaying the preview version of the electronic document includes the step of displaying portions of the electronic document at the client in 2-D (see Figure 1).*

Claim 16:

Blumberg discloses *the method of Claim 1, wherein:*

- *the step of generating preview document data at the printing device includes the steps of generating three-dimensional (3-D) preview document data (Page 10, Paragraph 0200 through Page 11, Paragraph 0210); and*

- *the step of displaying the preview version of the electronic document includes the step of displaying portions of the electronic document at the client in 3-D* (Page 10, Paragraph 0200 through Page 11, Paragraph 0210).

Claim 17:

Blumberg discloses *the method of Claim 1, wherein:*

- *the step of generating preview document data at the printing device includes the steps of generating HyperText Markup Language (HTML) data at the printing device* (the reference discloses a client communicating with an online printer; thus, the “printing device” *inherently* “generates HTML data”); and
- *the step of transmitting the preview document data to the client includes the step of transmitting the HTML data to the client from the printing device* (the reference discloses a client communicating with an online printer; thus, the “printing device” *inherently* “transmits HTML data” to the client).

Claim 18:

Blumberg discloses *the method of Claim 1, wherein:*

- *the step of generating preview document data at the printing device includes the steps of generating; Extensible Markup Language (XML) data at the printing device* (Pages 3 and 4, Paragraph 0061); and

- *the step of transmitting the preview document data to the client includes the step of transmitting the XML data to the client from the printing device (Pages 3 and 4, Paragraph 0061).*

Claim 19:

Blumberg discloses a *method for previewing an electronic document* (see Page 1, Paragraph 0009 – Blumberg discloses this limitation in that the cited paragraph states, “A user using the present invention can see on his video monitor how a document will look as a finished document”. (emphasis added).), *the method comprising:*

- *receiving from a client at a printing device document information associated with an electronic document, wherein the printing device includes a print process for generating hard-copy printouts of electronic documents at the printing device*
(EXAMINER’S INTERPRETATION OF “PRINTING DEVICE” – In the Drawings and Specification of the present invention, the “*printing device*” is illustrated in Figure 1A (element 102), Figure 1B (see element 102) and described in the text from Page 8, Line 3 to Page 11, Line 21. As illustrated in Figure 1A, the “*printing device*” comprises a “server process” (element 114) that receives print preview requests from a client (see Specification – Page 10, Lines 7-10). As illustrated in Figure 1B, the “*printing device*” comprises a “web server” (element 114) and a “system bus” (element 130) that allows a client to communicate with the printing device (see Specification – Page 11, Lines 10-21). In **Blumberg** – see Figures 2 and 3; see Page 3, Paragraph 0058 through Page 4, Paragraph 0074; see Page

7, Paragraph 0141 through Page 8, Paragraph 0154 – Blumberg discloses this limitation in that the computerized printing system comprises: 1) a computer network, comprising the components and connections of the system; 2) Virtual Builder, residing on servers and allowing a client user to select and view finishing options for a document via the client/server system; and 3) print servers connected to printers, for printing the document. Virtual Builder may reside only on server computers (see Page 3, Paragraph 0060, first sentence). Virtual Builder is implemented by software that interacts with web browser software on a client computer (see Page 3, Paragraph 0061, first sentence). The servers present a client user with an interface that enables him to select various finishing options (see Page 4, Paragraph 0065, first sentence). The client user can import a document into Virtual Builder (see Page 4, Paragraph 0066) and select various finishing options for the document (see Page 4, Paragraphs 0067-0073). Virtual Builder then displays the finished document (see Page 4, Paragraphs 0075-0076). Subsequently, the client user may submit the document to print servers in order to print the document (see Page 7, Paragraph 0142).

Accordingly, Blumberg discloses “*receiving from a client at a printing device document information associated with an electronic document, wherein the printing device includes a print process for generating hard-copy printouts of electronic documents at the printing device.*”;

- *the printing device generating preview document data based on the document information and a set of one or more specific characteristics associated with the*

printing device (This limitation corresponds to the third limitation in Claim 1. Also, the scope of this limitation is broader in that it excludes the language reciting “wherein the set of one or more specific characteristics are unavailable at the client” that is recited in the third limitation of Claim 1. Thus, as indicated in the above rejection for Claim 1, Blumberg discloses this limitation.); and

- *the printing device transmitting to the client the preview document data for causing a display unit associated with the client to display a preview version of the electronic document* (see Page 4, Paragraphs 0064-0083 – Blumberg discloses this limitation in that the computerized printing system comprises Virtual Builder. As indicated in the above discussion, Virtual Builder generates and displays the finished document (see Page 4, Paragraphs 0064-0083). Accordingly, Blumberg discloses “*the printing device transmitting to the client the preview document data for causing a display unit associated with the client to display a preview version of the electronic document.*”).

Claim 20:

Blumberg discloses *the method of Claim 19, wherein:*

- *the document information is Page Description Language (PDL) data; and*
- *the step of receiving document information includes receiving PDL data at the printing device* (Blumberg disclosed these limitations, as indicated in the rejection for Claim 3).

Claim 21:

Blumberg discloses *the method of Claim 19, wherein the step of generating preview document data at the printing device includes generating raster image data at the printing device based upon the document information and the set of one or more specific characteristics associated with the printing device* (Blumberg disclosed this limitation, as indicated in the rejection for Claim 4).

Claim 22:

Blumberg discloses *the method of Claim 19, wherein:*

- *the printing device is associated with one or more different paper characteristics that are available for printing electronic documents; and*
- *the set of one or more specific characteristics associated with the printing device includes one or more of the one or more different paper characteristics that are available for printing electronic documents* (Blumberg disclosed these limitations, as indicated in the rejection for Claim 6).

Claim 23:

Blumberg discloses *the method of Claim 19, wherein:*

- *the printing device is associated with one or more different finishing characteristics that are available for selection; and*
- *the set of one or more specific characteristics associated with the printing device includes one or more of the one or more different finishing characteristics that are*

available for selection (Blumberg disclosed these limitations, as indicated in the rejection for Claim 11).

Claim 24:

Blumberg discloses *the method of Claim 19, wherein the step of generating preview document data at the printing device further includes the steps of:*

- *determining a display resolution of the display device that is associated with the client; and*
- *generating the preview document data based on the display resolution of the display device* (Blumberg disclosed these limitations, as indicated in the rejection for Claim 14).

Claim 25:

Blumberg discloses *the method of Claim 19, wherein:*

- *the step of generating preview document data at the printing device includes generating three-dimensional (3-D) preview document data; and*
- *the step of transmitting to the client the preview document data includes transmitting preview document data that causes the preview version of the electronic document to be displayed in 3-D on the display unit associated with the client* (Blumberg disclosed these limitations, as indicated in the rejection for Claim 16).

Claims 26, 29-39 and 41-45:

Claims 26, 29-39 and 41-45 merely recite a computer-readable medium for performing the methods of Claims 1-12 and 14-18, respectively. Thus, Blumberg discloses every limitation of Claims 26, 29-39 and 41-45, as indicated in the above rejections for Claims 1-12 and 14-18.

Claim 27:

Blumberg discloses a *system for previewing an electronic document* (see Page 1, Paragraph 0009 – Blumberg discloses this limitation in that the cited paragraph states, “A user using the present invention can see on his video monitor *how a document will look as a finished document*” (emphasis added).), *comprising*:

- *one or more processors* (see Figures 2 and 3; see Page 2, Paragraph 0027 – Blumberg discloses this limitation in that the computerized printing system comprises multiple computer components on a computer network, and thus inherently has at least one processor because it involves computer components that “process” electronic data to perform the functions of the system.);
- *one or more memories coupled to the one or more processors* (see Page 2, Paragraph 0019 – Blumberg discloses this limitation in that the computerized printing system comprises a memory that stores finishing options.);
- *one or more sequences of instructions stored in the one or more memories* (see Figure 1; see Page 1, Paragraph 0010 – Blumberg discloses this limitation in that the computerized printing system comprises software.), *wherein execution of the*

one or more sequences of instructions by one or more processors causes the one or more processors to perform the steps of:

- *receiving from a client at a printing device, having a print process for generating hard-copy printouts of electronic documents at the printing device, document information associated with the electronic document;*
- *the printing device generating preview document data based on the document information and a set of one or more specific characteristics associated with the printing device; and*
- *the printing device transmitting the preview document data to the client for displaying a preview version of the electronic document at the client (as indicated in the above rejection for Claim 19, Blumberg discloses all of the above limitations).*

Claims 46-56 and 58-62:

Claims 46-56 and 58-62 correspond to Claims 1-12 and 14-18, respectively.

Thus, Blumberg discloses every limitation of Claims 46-56 and 58-62, as indicated in the above rejections for Claims 1-12 and 14-18.

Claim 28:

Blumberg discloses a *document preview apparatus* (see Page 1, Paragraph 0009 – Blumberg discloses this limitation in that the cited paragraph states, “A user

using the present invention can see on his video monitor *how a document will look as a finished document*" (emphasis added).), comprising:

- *a memory for storing characteristics that are associated with the document preview apparatus, wherein the characteristics are unavailable to clients that are connected to the document preview apparatus* (EXAMINER'S **INTERPRETATION OF “DOCUMENT PREVIEW APPARATUS”** – The “document preview apparatus” corresponds to the “printing device” recited in Claim 1. Thus, the examiner's interpretation of the “document preview apparatus” corresponds to the examiner's interpretation of the “printing device” recited in Claim 1. In **Blumberg** – see Page 2, Paragraph 0019; see Page 2, Paragraphs 0011-0012; see Page 4, Paragraphs 0064-0083 – Blumberg discloses this limitation in that the computerized printing system comprises a memory associated with Virtual Builder. As indicated in the above rejection for Claim 1, Blumberg discloses “characteristics [that] are unavailable to clients.” Accordingly, Blumberg discloses “*a memory for storing characteristics that are associated with the document preview apparatus, wherein the characteristics are unavailable to clients that are connected to the document preview apparatus.*”);
- *a print process for generating hard-copy printouts of electronic documents at the document preview apparatus* (Blumberg discloses this limitation, as indicated in the above rejection for Claim 1); and
- *one or more processors* (Blumberg discloses this limitation, as indicated in the above rejection for Claim 1) *that are configured for:*

- o *receiving, from a client, at a printing device document information associated with an electronic document;*
- o *generating, at the document preview apparatus, preview document data at the printing device based on the document information and a set of one or more specific characteristics associated with the printing device; and*
- o *transmitting to the client the preview document data for causing a display unit associated with the client to display a preview version of the electronic document* (These limitations correspond to the limitation recited in Claim 19. Thus, Blumberg discloses these limitations, as indicated in the above rejection for Claim 19.).

Claims 63-69:

Claims 63-69 merely recite a computer-readable medium for performing the methods of Claims 19-25, respectively. Thus, Blumberg discloses every limitation of Claims 63-69, as indicated in the above rejections for Claims 19-25.

Claims 70-76:

Claims 70-76 merely recite a computer apparatus medium for performing the methods of Claims 19-25, respectively. Thus, Blumberg discloses every limitation of these claims, as indicated in the above rejections for Claims 19-25.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 13, 40 and 57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Blumberg, in view of Bando, U.S. Patent No. 6,449,053.

Claim 13:

As indicated in the above discussion, Blumberg discloses every element of Claim

1. Blumberg also discloses a print driver that is associated with the printing device (as indicated in the rejection for Claim 12).

Blumberg fails to expressly disclose:

- *a print driver is that associated with one or more print driver attributes that are not supported by the printing device; and*
- *in the step of generating preview document data, wherein the document data at the printing device includes the step of translating one or more of the one or more print driver attributes into one or more printing device attributes that are supported by the printing device.*

Bando teaches:

- *a print driver is that associated with one or more print driver attributes that are not supported by the printing device* (see Column 1, Line 13 through Column 2, Line 30 – the printing device does not support all fonts in the PDL); and
- *translating one or more of the one or more print driver attributes into one or more printing device attributes that are supported by the printing device* (see Column 1, Line 13 through Column 2, Line 30 – the RIP converts PDL into raster image data),

for the purpose printing documents on the print device and reducing the overall cost of the computer network (see Column 1, Lines 62-67).

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method, disclosed in Blumberg, to include:

- *a print driver is that associated with one or more print driver attributes that are not supported by the printing device; and*
- *in the step of generating preview document data, the document data at the printing device includes the step of translating one or more of the one or more print driver attributes into one or more printing device attributes that are supported by the printing device,*

for the purpose printing documents on the print device and reducing the overall cost of the computer network, as taught by Bando.

Claim 40:

Claim 40 merely recites a computer-readable medium for performing the method of Claim 13. Thus, Blumberg, in view of Bando, discloses/teaches every limitation of Claim 40 and provides proper motivation to combine the references, as indicated in the above rejection for Claim 13.

Claim 57:

Claim 57 merely recites a computer system for performing the method of Claim 13. Thus, Blumberg, in view of Bando, discloses/teaches every limitation of Claim 57 and provides proper motivation to combine the references, as indicated in the above rejection for Claim 13.

(10) Response to Argument

Applicant's arguments filed 18 January 2005 have been fully considered but they are not persuasive.

A. Introduction

Applicant states that a sufficient factual basis has not been proffered during the prosecution of the present application to support the rejection of Claims 1-12, 14-39, 41-56 and 58-76 under 35 U.S.C. 102(e) as being anticipated by Blumberg or the rejection of Claims [1]3, 40 and 57 under 35 U.S.C.103(a).

The examiner disagrees, as indicated in the following discussion.

B. Applicants Arguments for Claims 1-12, 14-39, 41-56 and 58-76

Applicant generally argues that Blumberg fails to disclose "*the printing device generating preview document data based on the document information and a set of one or more specific characteristics associated with the printing device, wherein the set of one or more specific characteristics are unavailable at the client*" and the "*printing device having a print process executing thereon for generating hard-copy printouts of electronic documents at the printing device*" (emphasis added), as recited in Claim 1.

See *Applicant's Appeal Brief* – Page 4, third paragraph.

Even though the words do not significantly affect the scope of the limitation, the examiner points out that the words "*executing thereon*" are not recited in Claim 1.

i. Applicants Arguments that Blumberg Does Not Teach or Suggest the Claim 1 Limitations "*the printing device generating preview document data . . .*" and "*the printing device transmitting the preview document data to the client*"

Applicant argues that Blumberg fails to disclose a "*printing device*" that:

1) "*generat[es] preview document data;*" and 2) "*transmit[s] the preview document data to the client,*" as recited in Claim 1, because the Virtual Builder software does not reside

on a “*printing device*” that can: a) execute the Virtual Builder software; or b) otherwise be configured to generate preview document data” and provide the preview document data to a client. Applicant acknowledges that Virtual Builder can reside on client computers, server computers and an on-demand print server. Applicant also acknowledges that Virtual Builder can be part of an on-demand print service in an online on-demand print facility. However, Applicant argues, none of these components on which Virtual Builder resides is a “*printing device*.” Applicant states that the only “*printing devices*” in Blumberg are local printer 260 and the “*printing devices*” at the corporate reproduction center 280, local reproduction center 370 and remote production center 380. See *Applicant’s Appeal Brief* – Page 5, first paragraph through Page 6, first full paragraph.

The examiner disagrees.

The issue of this dispute is: whether Virtual Builder resides on a “*printing device*.” In the argument, Applicant appears to define the scope of “*printing device*” as limited to comprise only printers.

During patent examination, the pending claims must be “given their broadest reasonable interpretation consistent with the specification.” *In re Hyatt*, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000).

In the Drawings and Specification of the present invention, the “*printing device*” is illustrated in Figure 1A (element 102), Figure 1B (see element 102) and described in the text from Page 8, Line 3 to Page 11, Line 21. As illustrated in Figure 1A, the “*printing device*” comprises a “server process” (element 114) that receives print

preview requests from a client (see Specification – Page 10, Lines 7-10). As illustrated in Figure 1B, the “**printing device**” comprises a “web server” (element 114) and a “system bus” (element 130) that allows a client to communicate with the printing device (see Specification – Page 11, Lines 10-21). Thus, the “**printing device**” comprises several different components of computer hardware and computer software, all of which contribute towards the printing of a hardcopy document. Moreover, the **entire** computer system of the present invention, illustrated in Figure 5, is described as a “printing device” computer system (see Specification – Page 17, Line 12).

Accordingly, the scope of the term “**printing device**,” as illustrated and described in the present application, is extremely broad and includes every piece of computer hardware that includes the Virtual Builder software. Moreover, the term comprises the Virtual Builder software itself.

Appellant acknowledges that Virtual Builder generates document previews that include user-selected finishing options (see *Appeal Brief* – Page 5, first paragraph, third sentence). Appellant also acknowledges that Blumberg discloses an online printing service that allows a user to preview how a finished document will look (see *Appeal Brief* – Page 5, first paragraph, first sentence). In order for an online user to preview the finished document, the document preview that is generated by the Virtual Builder software residing on the servers must be transmitted to the client user.

Accordingly, as indicated in the above discussion and explained in the above rejections, Blumberg discloses a “**printing device**” that: 1)“*generat[es] preview document data;*” and 2) “*transmit[s] the preview document data to the client.*”

ii. **Appellant's Arguments that Blumberg Does Not Teach or Suggest the Claim 1 Limitation “*the printing device generating preview document data based on the document information and a set of one or more specific characteristics associated with the printing device, wherein the set of one or more specific characteristics are unavailable at the client*”**

Appellant argues that Blumberg fails to disclose a “*set of one or more specific characteristics [that] are unavailable at the client*” because the finishing options of the Virtual Builder software are selected by the user at the client. Thus, Appellant argues, the finishing options of Virtual Builder are “available” at the client. See *Appeal Brief* – Page 9, first full paragraph.

The examiner disagrees.

The present invention operates in a manner that is at least very highly similar to the computerized printing system disclosed in Blumberg. As described in the Specification of the present invention, an interface is presented to a client user that allows the user to select finishing options that are “**not available**” at the client computer (generally, see Page 14, Line 14 through Page 17, Line 10; more specifically, see Page 15, Lines 15-20).

Additionally, in Blumberg, the finishing options presented to the client user through Virtual Builder are “**unavailable at the client**” in that the finishing options are “available” only through accessing the Virtual Builder software, which resides on the

servers. That is, without accessing Virtual Builder, the finishing options are not available at the client.

Accordingly, as indicated in the above discussion and explained in the above rejections, Blumberg discloses a “*set of one or more specific characteristics [that] are unavailable at the client.*”

Appellant’s Arguments for Claims 2-12, 14-39, 41-56 and 58-76

Appellant’s argument for these claims rely upon the arguments previously set forth and addressed in the above discussion.

C. Appellant’s Arguments for Claims 13, 40 and 57

Appellant’s argument for Claims 13, 40 and 57 rely upon the arguments previously set forth and addressed in the above discussion.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



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